

Remarks:

Claims 1-20 are pending. Applicant has amended the claims to distinctively claim the subject matter of the invention. By virtue of this amendment, claims 1, 10, 11, and 20 are amended. No new matter is added as support for the amendments is found within the Specification and the drawings. It is submitted that the application, as amended, is in condition for allowance.

Objection(s):

Claim 10 is objected to for depending on claim 11, which is an apparatus claim. Claim 10 has been amended to depend from claim 9.

§112 Rejection(s):

Claims 1-20 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. The Examiner contends that the Specification and the drawings do not disclose the recited claimed language related to “automatically configuring the mobile device to operate in the mobile communications network, without input from a user or a service representative.” This rejection is respectfully traversed.

The Examiner is reminded that §112, first paragraph, requires for the Specification to adequately support the subject matter claimed rather than mirroring the claim language word for word. MPEP §2163, *Moba, B.V. v. Diamond Automation, Inc.*, 325 F.3d 1306, 1319, 66 USPQ2d 1429, 1438 (Fed. Cir. 2003); *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d at 1563, 19 USPQ2d at 1116.

Support can be provided “in a variety of ways” and “using such descriptive means as words, structures, figures, diagrams, and formulas” to “show that the applicant was in possession of the claimed invention. *Lockwood v. American Airlines, Inc.*, 107 F.3d

1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997). See, e.g., *Pfaff v. Wells Elecs., Inc.*, 525 U.S. 55, 68, 119 S.Ct. 304, 312, 48 USPQ2d 1641, 1647 (1998).

Further, claim limitations may be supported in the Specification through “express, implicit, or inherent disclosure.” See *In re Oda*, 443 F.2d 1200, 170 USPQ 268 (CCPA 1971). Paragraph [0001] of the Specification expressly discloses “automatically configuring a mobile device receiving a new identification module for communicating in a mobile communications network.” Paragraphs [0008] through [0010] of the Specification implicitly disclose configuration of a mobile device without input from a user or service representative. Thus, support for the rejected claim language is found within the Specification and the drawings.

Referring to MPEP 2163 (II) (A), “[t]he examiner has the initial burden, after a thorough reading and evaluation of the content of the application, of presenting evidence or reasons why a person skilled in the art would not recognize that the written description of the invention provides support for the claims. There is a strong presumption that an adequate written description of the claimed invention is present in the specification as filed, *Wertheim*, 541 F.2d at 262, 191 USPQ at 96.”

Respectfully, the Examiner has misinterpreted the requirements of §112 in rejecting the claims. Pursuant to MPEP §2163 (II) (A) and §2163.04, the Examiner is requested to present “evidence or reasoning to explain why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims,” or otherwise withdraw the rejection.

§102 Rejection(s):

Claims 1-3, 6, 7, 8-17, 19, and 20 are rejected under 35 U.S.C. §102(b) as being unpatentable over U.S. Patent No. 6,463,300 to Oshima (hereafter “Oshima”). This rejection is respectfully traversed.

It is respectfully noted that anticipation of a claim under 35 U.S.C. §102 (a), (b) and (e) requires that "each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference," that "[t]he identical invention must be shown in as complete detail as is contained in the ... claim" and "[t]he elements must be arranged as required by the claim." MPEP §2131.

Oshima is directed to preventing unauthorized use of a mobile device in a mobile communication network when the device's SIM card is changed. See column 3, lines 1-18. Various data from a SIM card inserted in the mobile device when the mobile device previously accessed the network is stored in a SIM card data storing section 252 of the mobile device's memory 25. The stored previous SIM card data is used to detect whether a new SIM card is inserted in the mobile device the next time the mobile device attempts to access the network. See column 6, lines 28-41. Upon detecting a new SIM card, the mobile device requests a secret number from a user of the mobile device. The mobile device is allowed to access the mobile communication network only if the user correctly inputs the secret number. See column 6, lines 43-54.

Oshima fails to disclose at least one of the elements recited in claim 1, as amended. In particular, Oshima fails to disclose (1) searching a data structure external to the first identity module for first configuration data associated with the first identity module, in response to determining the first identity module is different from the second identity module; and (2) automatically configuring the mobile device to use the first configuration data to operate in the mobile communications network, in response to finding the first configuration data in the data structure.

Respectfully, the Examiner has misapplied Oshima to the above-mentioned elements of claim 1. In Oshima, the SIM card data stored in the memory 25 is associated with a SIM card inserted in the mobile device when the mobile device previously

accessed the network (i.e., a previous SIM card). See column 6, lines 28-32. In claim 1, on the other hand, the first configuration data stored in the data structure is associated with the first identity module (e.g., a new SIM card).

Moreover, Oshima discloses using the SIM card data stored in the memory 25 to detect whether a new SIM is inserted in the mobile device. Claim 1, on the other hand, recites using the first configuration data stored in the data structure to operate in the mobile communications network after a new SIM card is detected. That is, Oshima fails to disclose that the SIM card data stored in the memory 25 is used to operate in the mobile communications network after a new SIM card is detected.

In fact, Oshima teaches away from using the SIM card data stored in the memory 25 to operate in the mobile communications network after a new SIM card is detected. Since the SIM card data stored in the memory 25 is associated with a SIM card previously inserted in the mobile device, it cannot be used when a new SIM card is inserted in the mobile device. As such, Oshima directly teaches away from “automatically configuring the mobile device to use the first configuration data to operate in the mobile communications network, in response to finding the first configuration data in the data structure,” as recited in claim 1.

Since Oshima fails to disclose at least one of the elements recited in claim 1, the §102 rejection should be withdrawn with respect to claim 1. Therefore, it is submitted that claim 1 is in condition for allowance. Claims 2-10 depend on claim 1 and should also be in condition for allowance by virtue of their dependence on an allowable base claim. Claim 11, as amended, incorporates the elements of claim 1; therefore, claim 11 and claims 12-20 depending from claim 11 should also be in condition for allowance.

§103 Rejection(s):

Claims 4, 5, 8, and 18 are rejected under 35 U.S.C. §103(a) as being unpatentable over Oshima in view of U.S. Patent Publication No. 2004/01953213 to Lee (hereafter “Lee”). This rejection is respectfully traversed.

It is respectfully noted that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Since Oshima teaches away from claim 1, it would be unreasonable to suggest that a person of ordinary skill in the art would be motivated to combine Oshima with Lee or any other reference. Accordingly, Oshima should be withdrawn for being an improper reference. Even assuming, *arguendo*, that Lee could be combined with Oshima, Lee fails to cure the deficiencies of Oshima.

Lee is directed to a method for registering network information in a mobile terminal using a smart card. The method comprises receiving system network set-up information from a wireless communication system; connecting a smart card to the mobile terminal and determining if there is network set-up information in the smart card; storing the newly-acquired network set-up information in a file stored in the smart card if there is no network set-up information present in the smart card; comparing the existing network set-up information in the smart card with the newly-acquired system network set-up information; and updating existing network set-up information with the newly-acquired system network set-up information. See Abstract.

Lee fails to cure the deficiencies of Oshima as Lee fails to teach or suggest (1) searching a data structure external to the first identity module for first configuration data

associated with the first identity module, in response to determining the first identity module is different from the second identity module; and (2) automatically configuring the mobile device to use the first configuration data to operate in the mobile communications network, in response to finding the first configuration data in the data structure, as recited in claim 1.

Further, while the suggestion to modify or combine references may come from the knowledge and common sense of a person of ordinary skill in the art, the fact that such knowledge may have been within the province of the ordinary artisan does not in and of itself make it so, absent clear and convincing evidence of such knowledge. *C.R. Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340, 1352, 48 USPQ 2d 1225, 1232 (Fed. Cir. 1998).

Here, the modification or combination proposed by the Examiner is not based on any clear and convincing evidence of a reason, suggestion, or motivation in the prior art that would have led one of ordinary skill in the art to combine the references. Rather, the reason, suggestion and motivation for the combination of references proposed by the Examiner simply is impermissible hindsight reconstruction given the benefit of Applicant's disclosure.

The Federal Circuit has consistently held that hindsight reconstruction does not constitute a prima facie case of obviousness under 35 U.S.C. §103. *In re Geiger*, 2 USPQ 2d 1276 (Fed Cir. 1987). Unfortunately, the Examiner rather than pointing to what the prior art discloses and teaches as to making the suggested modification relies on assumptions and statements without any support in the record. As such, the Examiner's statements regarding obviousness and motivation to modify are but shortcuts to a conclusion of obviousness devoid of the required analytical approach based on what is actually disclosed in the prior art.

Reliance on impermissible hindsight to avoid express limitations in the claims and setting forth unsupported hypothetical teachings to recreate the Applicant's claimed invention cannot establish a prima facie case of obviousness. Since obviousness may not be established by hindsight reconstruction, Applicant invites the Examiner to point out the alleged motivation to combine with specificity,¹ or alternatively provide a reference or affidavit in support thereof, pursuant to MPEP §2144.03.²

Since no reasonable justification is provided in the Office Action as to how such modification or combination is possible and obviousness may not be established based on hindsight and conjecture, it is respectfully requested that the §103 rejection be withdrawn.

For the above reasons, none of the cited references, either alone or in combination, teach or suggest all the elements recited in claim 1. Therefore, it is submitted that claim 1 is in condition for allowance. Claims 2-10 depend on claim 1 and should also be in condition for allowance by virtue of their dependence on an allowable base claim. Claim 11, as amended, incorporates the elements of claim 1; therefore, claim 11 and claims 12-20 depending from claim 11 should also be in condition for allowance.

No amendment made was related to the statutory requirements of patentability unless expressly stated herein; and no amendment made was for the purpose of narrowing the scope of any claim, unless Applicant has expressly argued herein that such amendment was made to distinguish over a particular reference or combination of references.

¹ *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984).

² "The rationale supporting an obviousness rejection may be based on common knowledge in the art or "well-known" prior art . . . If the applicant traverses such an assertion the examiner should cite a reference in support of his or her position. When a rejection is based on facts within the personal knowledge of the examiner . . . the facts must be supported, when called for by the applicant, by an affidavit from the examiner."

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles, California, telephone number (888) 789 2266 to discuss the steps necessary for placing the application in condition for allowance.

Respectfully submitted,

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